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10/560,040

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9447

60333

7590

02/03/2009

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EXAMINER

MEYERS, MATTHEW S

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/560,040

**Applicant(s)**

GILLESPIE, DAVID

**Examiner**

MATTHEW S. MEYERS

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-893)  
Paper No(s)/Mail Date 12/7/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to applicant's communication on 12/07/05, wherein claims 1-12 have been cancelled and claims 13-27 have been added. Therefore, claims 13-27 are currently pending.

***Priority***

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 12/7/05 is being considered by the examiner.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what applicant is claiming by a software questionnaire module. For examination purposes, Examiner will interpret module to be a

logically separable part of a program which is consistent with the IEEE standard definition.

6. Claims 13-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner has determined that applicant wishes to invoke 35 U.S.C. 112, sixth paragraph for claims 13-27, since the claims meet the 3-prong analysis set out in MPEP 2181 which states a claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis: (A) the claim limitations must use the phrase "means for" or "step for;" (B) the "means for" or "step for" must be modified by functional language; and (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

7. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. After reviewing applicant's specification there is no reference to any sufficient structure or material to perform or achieve the specified function in applicant's claims. Applicant is required to:

- a. (a) Amend the claim so that the claim limitation will no longer be a means plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- b. (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a))

8. If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- c. (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or
- d. (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP 2181 and 608.01(0).

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 13-27 are rejected under 35 U.S.C. 101 the claimed invention is directed to non-statutory subject matter because they are drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter. To be statutory, a

computer program must be coupled with or combined with some statutory physical structure.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 13-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Peters et al. (US 5,893,098) (Hereinafter referred to as Peters)

13. With respect to **Claim 13**:

14. Peters discloses a software questionnaire module for online use, comprising:

- e. means for electronically distributing a questionnaire (Peters Fig. 1);
- f. means for monitoring deadlines for responding to said questionnaire (Peters col. 11, lines 1-5, "controlling a processing apparatus to monitor incoming transmissions to the processing apparatus and identify response documents to the survey, and to process the response documents to load a database in accordance with the responses to the at least one question.");
- g. means for effecting reminders of said deadlines for responding to said questionnaire (Peters col. 21, lines 27-42, "If after a few days the collator (local user) notices that the responses have slowed down to a trickle he may like to send all those who have not yet responded a quick reminder. This can be done

automatically by selecting the SURVEY/REMIND menu option (FIG. 12 (b)).");

and,

h. means for distributing results of said questionnaire to select users of said software questionnaire module (Peters Fig. 15, "Mail Survey...").

15. With respect to **Claim 14:**

16. Peters discloses at least one menu accessible to users required to answer said questionnaire (Peters, at least Fig 6).

17. With respect to **Claim 15:**

18. Peters discloses wherein said at least one menu is accessible to authors of said questionnaire (Peters, at least Fig 11a).

19. With respect to **Claim 16:**

20. Peters discloses wherein said at least one menu includes means for selecting a plurality of questionnaires to which said users are entitled to access (Peters, at least Fig 4).

21. With respect to **Claim 17:**

22. Peters discloses further comprising means for allowing a respondent of said questionnaire to access said questionnaire and respond to said questionnaire on a display screen (Peters col. 11, lines 28-34, "FIGS. 2 through 11e show samples of video display screens showing information presented during various stages of preparation of a survey document and answer document (response document), such as may be presented by a display means of a processing apparatus in accordance with an embodiment of the present invention.").

23. With respect to **Claim 18**:

24. Peters discloses further comprising means for permitting an author of said questionnaire to either respond to said questionnaire, edit said questionnaire or view responses to said questionnaire (Peters, at least Figs 11a-11g).

25. With respect to **Claim 19**:

26. Peters discloses further comprising means for permitting respondents to access said questionnaire only with authorization to do so and means for permitting an author of said questionnaire to also access all said questionnaires said author has written (Peters col. 1, lines 10-15, "the invention relates to a method and system for asking questions of computer users having access to electronic mail..." and Fig. 15).

27. With respect to **Claim 20**:

28. Peters discloses further comprising means for permitting an author of said questionnaire to define a title, a description and a due date for said questionnaire (Peters, at least Figs 11a-11g).

29. With respect to **Claim 21**:

30. Peters discloses further comprising means for permitting said author of said questionnaire to list questions (Peters, at least Fig 11a-11g).

31. With respect to **Claim 22**:

32. Peters discloses further comprising means for permitting said author of said questionnaire to specify which persons are to respond to said questionnaire (Peters, col. 25, lines 56-57, "The user is presented with a list of E-Mail users (via the MAPI mail interface) for the remote users (or groups of remote users) to be selected.").



33. With respect to **Claim 23**:

34. Peters discloses further comprising means for automatically notifying said select users when said questionnaire is complete, means for informing when said questionnaire is available for viewing and means for informing when said questionnaire is approaching its due date (Peters col. 21, lines 27-42, "If after a few days the collator (local user) notices that the responses have slowed down to a trickle he may like to send all those who have not yet responded a quick reminder. This can be done automatically by selecting the SURVEY/REMIND menu option (FIG. 12 (b)).").

35. With respect to **Claim 24**:

36. Peters discloses further comprising a summary for said questionnaire (Peters col. 3, lines 48-63, "Because the information is automatically processed and presented in a database, there is no need to undertake the laborious job of individually processing each response document. An immense amount of time can be saved. Because of the automatic collation, a single survey author may poll thousands of respondent users, their responses being processed for him automatically almost as soon as they arrive.").

37. With respect to **Claim 25**:

38. Peters discloses further comprising means for permitting an author to run customized reports based upon a group of users (Peters col. 3, lines 48-63, "Because the information is automatically processed and presented in a database, there is no need to undertake the laborious job of individually processing each response document. An immense amount of time can be saved. Because of the automatic collation, a single

survey author may poll thousands of respondent users, their responses being processed for him automatically almost as soon as they arrive.”).

39. With respect to **Claim 26:**

40. Peters discloses further comprising means for generating an audit trail for said questionnaire (Peters col. 4, lines 1-4, "Each database field for an answer is preferably uniquely identified by a column label, which may relate to the question asked, and a "row" label which relates to the identity of the respondent user.”).

41. With respect to **Claim 27:**

42. Peters discloses further comprising means for permitting an author of said questionnaire to provide any respondent to said questionnaire with an e-mail notification advising said any respondent that said author is dissatisfied with answers provided to said questionnaire and that said any respondent should again answer said questionnaire (Peters col. 4, lines 30-33, " It would then, for example, be possible to mail back further questions to persons giving a particular response to one or more questions in a previous survey document.”)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. MEYERS whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S. Meyers/  
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
January 31, 2009